

## REMARKS

Claims 1-24 are pending in the application. Claims 12-20 were withdrawn from consideration by the Examiner as being directed to a non-elected invention. Claims 21-24 are newly added.

Withdrawal of the rejection of Claims 5-11 under 35 USC § 112, second paragraph, as being indefinite is respectfully requested in light of amendments thereto as set forth hereinabove. The amendments were substantially along the lines proposed by the Examiner and place the rejected claims in compliance with Section 112.

Claims 1-3 and 6-8 have been rejected under 35 USC § 102(b) as anticipated by Kranik et al. (U.S. Patent No. 4,425,829) or, in the alternative, under 35 USC § 103(a) as obvious over Kranik et al. in view of Shimizu et al. (U.S. Patent No. 5,214,991).

It is noted that anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims. *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985). There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. § 102. *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991). In view of the foregoing authority, the cited reference fails to support the asserted rejection.

It is noted that to establish a *prima facie* case of obviousness under §103, all claim limitations of a claimed invention must be taught or suggested by the prior art. See MPEP § 2143.03 and *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

In view of the foregoing authority, the cited reference(s) fail to support the asserted rejection.

It is further noted that the invention is to be considered as a whole in determining obviousness. The Federal Circuit has held, for example, that "[f]ocusing on the obviousness of substitutions and differences instead of on the invention as a whole ... [is] a legally improper way to simplify the difficult determination of obviousness." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986). Moreover, "[c]asting an invention as a 'combination of old elements' leads improperly to an analysis of the claimed invention by the parts, not by the whole." *Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 1 USPQ2d 1196 (Fed. Cir. 1986). Further, "[i]t is impermissible ... to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

As recited in Claim 1, the present invention relates to a punch and die alignment system which comprises a first die including a first die aperture for receiving a punch. The system further includes a second die including a second die aperture for receiving the punch, and a first housing including a first die passage receiving at least a portion of the first die.

The system further includes a second housing including a second die passage receiving at least a portion of at least one of the first die and the second die. The

second die receiving passage is configured to permit at least one of the first die and the second die to rotate therein, thereby permitting the first die aperture and the second die aperture to be aligned with each other.

The claimed structure is absent from the cited references, rendering the rejection untenable in light of the above-cited authority. For example, there is no mention in either Kranik et al. or Shimizu et al. of a second die receiving passage being configured to permit at least one of the first die and second die to rotate therein, thereby permitting the first die aperture and the second die aperture to be aligned with each other. The two references are completely silent as to rotation of dies within a die passage for alignment thereof.

The Examiner contends that the recited limitation is met by Kranik et al. because the limitation is “interpreted as defining the second die passage as being round thus permitting rotation therein.” Further, the Examiner takes official notice that “round dies fitted into round die passages are old and well-known in the art” and “provide well-known benefits including ease of manufacture and assembly.”

In view of the foregoing remarks by the Examiner, Applicant respectfully submits that the Examiner is engaging in an improper casting of the invention as a combination of old elements, and improperly engaging in hindsight reconstruction using the Applicant’s disclosure as a reference as discussed in the above-cited case law. Within the Applicant’s experience, dies which are rotatable within a receiving passage for purposes of aligning die apertures is new art. In the prior art, such as a punch

apparatus as disclosed in Kranik et al. dies (die bushings) are tightly pressure-fitted in receiving passages. The die bushings are inserted into their receiving passages by being tapped in with a hammer or hammer-like tool. Rotation within the die bushing receiving passage is not possible. To change the respective alignment of die bushings as suggested by the Examiner, it would be necessary to remove the respective die bushings, again by tapping them out with some manner of tool, changing their respective orientations externally to the die receiving passages, and reinserting them.

In contrast, the present application discloses and claims an alignment system designed for easily facilitating the alignment of die apertures as noted in the present specification at, for example, Page 11, lines 20-24 and Page 12, line 1. This matter describes how an upper die and a lower die may be rotated relative to each other within a die receiving passage, as further illustrated in Fig. 2.

Moreover, as discussed in the present specification on Page 15, lines 17-24 and Page 16, lines 1-6, the upper housing 32 and lower housing 33 may be free for rotation relative to each other. This clarifies that the present invention provides for ease of alignment, since the dies do not need to be removed from their respective housings in order to change their positions relative to each other, as would be required in Kranik.

Claim 2 is dependent upon Claim 1 and consequently incorporates the feature that the second die receiving passage is configured to permit at least one of the first die and the second die to rotate therein, which is absent from the cited prior art as

demonstrated above. Claim 2 further recites that the second die passage receives at least a portion of the second die and at least a portion of the first die.

The Examiner contends that Kranik et al. teaches the limitation of Claim 2 because a first die shown in an "extended position" and Fig. 1 of Kranik shows an "intended use" anticipating or rendering obvious Applicant's claimed invention.

Applicant respectfully submits that the foregoing constitutes impermissible hindsight. As discussed above, rotation of the die bushings of Kranik et al. within their respective die passages is not possible within Applicant's experience. Moreover, as shown in Fig. 2 of the present application, a lower die is displaced downwardly within a die receiving passage 34, while a portion of an upper die 25 is inserted into the lower die receiving passage 34. Fig. 1 of Kranik shows no such displacement of a lower die bushing to accommodate an upper die bushing. Thus, Applicant respectfully disagrees that the structure in Kranik in any way teaches or suggests the rotation of dies relative to each other within a common die receiving passage for purposes for alignment.

Claim 3 incorporates the features of Claim 1, and consequently incorporates the features demonstrated to be absent from the references.

Independent Claim 6 recites substantially the features of Claim 1, including that the second die receiving passage is configured to permit at least one of the first die and the second die to rotate therein. As discussed above, any teaching or suggestion of this feature is absent from the references.

Claim 7 was rejected upon substantially the same basis as Claim 2, which has been discussed above. Moreover, Claim 7 is dependent on Claim 6 and consequently incorporates the features absent from the prior art.

Claim 8 was rejected on substantially the same basis as Claim 3, which has been discussed above. Moreover, Claim 8 is dependent on Claim 6 and consequently incorporates the features demonstrated to be absent from the prior art.

In view of the foregoing discussion, withdrawal of the rejection of Claims 1-3 and 6-8 as being either being anticipated by or obvious in view of the cited reference is respectfully requested. The present application discloses and claims features which are in no way taught or suggested by the cited references, rendering the rejection untenable.

Withdrawal of the rejection of Claims 4, 5, 8, 9 and 11 under 35 USC § 103 as being unpatentable over Kranik et al. or in the alternative, over Kranik et al. in view of Shimizu et al. is respectfully requested.

Each of the rejected claims is dependent upon either Claim 1 or Claim 6 and consequently incorporates the features demonstrated to be absent from the cited prior art. In view of this, the rejection under 35 USC § 103(a) is untenable in view of the requirements for sustaining a Section 103 rejection as cited above.

New Claims 21-24 are addressed to features which are also absent from the cited references. New Claims 21 and 22 are addressed to the rotatable upper and lower housings as discussed above. New Claims 23 and 24 recite means for sensing a

frictional resistance between the punch and first and second die apertures as described on Page 17, lines 7-12 of the present specification. The means for sensing the frictional resistance allows for the high degree of concentricity between the first and second die apertures which is enabled by the method described in the disclosure.

In light of the above discussion, Applicant respectfully submits that the present application is in all aspects in compliance with Section 112, and in no way anticipated or rendered obvious by the prior art. Accordingly, favorable reconsideration and early issuance of a Notice of Allowance are respectfully requested.

The Director is hereby authorized to charge any insufficient fees, or credit any overpayment, associated with this communication, including any extension fees, to Deposit Account No. 22-0185. A duplicate of the authorization is attached for the Finance Branch.

In the event that any further cooperation in this case is deemed to be necessary to complete its prosecution, the Examiner is respectfully urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Curry". The signature is fluid and cursive, with a long horizontal stroke at the end.

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